


REMARKS

Claims 1-32 are pending in the present application. Claims 19 and 22-26 have been amended to overcome the rejections based upon 35 U.S.C. 112, second paragraph.

Claims 1-32 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 2,935,152 to Maccaferri in view of U.S. Patent 6,467,228 to Wendt. U.S. Patent No. 6,467,228 has been assigned to USG, the assignee of the present application. In the office action it was stated that Maccaferri teaches acoustical units comprising a plurality of tile panels T forming rows, each of the tile panels T having a body 10 tilted and inclined or tapered across edge walls thus having different depths, a planar surface 14. The office action also states that the tile panels T are enclosed by edge flanges 11 and are arranged in straight rows. The office action further states that Maccaferri does not expressly teach the units comprising a plurality of grid members intersection to form a grid, wherein each of the grid members includes a base and bridge members.

After reviewing Maccaferri, it is clear that the acoustical units of Maccaferri are not designed to be suspended from a grid system having grids with base and bridge members. Maccaferri does not include outwardly extending flanges that rest upon the base portion of the grid members in a grid system. Figure 13 of Maccaferri clearly illustrates that the acoustical units are interconnected by use of pins 30 which connect with openings 31 on the sides of the panels. The tiles of Maccaferri are sound absorbing tiles. In order to obtain the proper sound absorption, the tiles must be placed in a touching relationship so that no sound can be deflected downward which occur if there were a gap between panels. In column 7, lines 23-26 Maccaferri states that in the installation of the tiles it is undesirable to leave any appreciable spacing between the adjacent side edge flanges of adjacent tiles so that in the preferred installations

A handwritten bracket on the right side of the page, spanning from the first sentence of the second paragraph to the last sentence of the second paragraph. A checkmark is written to the right of the bracket.

adjacent side edge flanges are either abutting or very minutely spaced. Applicant's claimed invention utilizes sloped or tapered panels that are suspended by use of a grid system. The grid members in the grid system are T-shaped having a base member, a bulb portion and a bridge member interconnecting the base member with the bulb portion. The positioning of the tapered panels on the grid members creates an appreciable space between the panels as clearly shown in figures 2 and 3 of the present application. Use of metal grid members with the acoustical units of Maccaferri would not only create an appreciable gap between the panels, it would create a non-sound absorbing metal structure that would reflect sound and not absorb it. An attempt to combine Wendt with Maccaferri would contradict the teachings of Maccaferri. There is no motivation, teaching or suggestion to combine these two references to arrive at the applicant's present invention.

Numerous cases which have been decided by the Federal Circuit state the proposition that there must be a teaching or suggestion in the cited references to modify them as suggested by the Examiner. See, for example, Ben W. Vandenberg et al. v. Dairy Equipment Co., 224 USPQ 195 (Fed. Cir. 1984).

The issue of obviousness or non-obviousness was discussed in an opinion of the Federal Circuit entitled Orthopedic Equipment Co., Inc. v. U.S., 217 USPQ 193 (Fed. Cir. 1983). The Federal Circuit noted that the question of non-obviousness is a simple one to ask, but difficult to answer. There the Court was confronted with a situation in which the prior art showed each of the elements of the disputed claims. The question, the Court said, becomes whether it would have been obvious to a person of ordinary skill in the art to "coordinate" these elements in the same manner as the disputed claims. In cautioning against the use of hindsight in answering this question, the Court stated at page 199:

"The difficulty which attaches to all honest attempts to answer this

question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law”.

In In re Rijckaert, 28 USPQ2d 1955 (CAFC 1993) the Court of Appeals outlined the burden on the Patent and Trademark Office as follows:

“In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. In *re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. *Id.* “A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.” In *re Bell*, 991 F.2d 781, 782, 26 USPQ2d 1529, 1531, (Fed. Cir. 1993) (quoting in *re Rinehart*, 531 F.2d 1048, 1-51, 189 USPQ 143, 147, (CCPA 1976)). If the Examiner fails to establish a *prima facie* case, the rejection is improper and will be overturned. In *re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).”

There is no objective teaching in Maccaferri to suggest that the acoustical units, which are required to be in contact with each other and are void of any means for connecting the acoustical units to the grid, could be used in a grid system as taught by Wendt. Only Applicant’s specification and drawings provide that teaching.

More recently, the Federal Circuit gave additional guidance when rejecting claims as obvious over a combination of prior art references. The Court in In re Dembiczak, 50 USPQ2d 1614 (1999) reversed a rejection of claims as obvious over a combination of prior art references. The Court stated at page 1616:

“Our analysis begins in the text of section 103 quoted above, with the phrase “at the time the invention was made.” For it is this phrase that guards against entry into the “tempting but forbidden zone of hindsight,” see *Loctite Corp. v. Ultraseal, Ltd.*, 781 F.2d 861, 873, 228 USPQ 90, 98, (Fed. Cir. 1985), overruled on other grounds by *Nobelpharma AB v. Implant Innovations, Inc.*, 141 F.3d 1059, 46 USPQ2d 1097 (Fed. Cir. 1998), when analyzing the patentability of claims pursuant to that section. Measuring a claimed invention against the standard established by

section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. *See e.g., W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313, (Fed. Cir. 1983). Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one “to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher”. *Id.*

Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. *See, e.g. C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232, (Fed. Cir. 1998) (describing “teaching or suggestion or motivation [to combine]” as an “essential evidentiary component of an obviousness holding”); *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) (“the Board must identify specifically.... the reasons one of ordinary skill in the art would have been motivated to select the references and combine them”); *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783, (Fed. Cir. 1992) (examiner can satisfy burden of obviousness in light of combination “only by showing some objective teaching [leading to the combination]”); *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) (evidence of teaching or suggestion “essential” to avoid hindsight); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.* 776 F.2d 281, 297, 227 USPQ 657, 667 (Fed. Cir. 1985) (district court’s conclusion of obviousness was error when it “did not elucidate any factual teachings, suggestions or incentives from this prior art that showed the propriety of combination”). *See also Graham*, 3838 U.S. at 18, 148 USPQ at 467 (“strict observance” of factual predicates to obviousness conclusion required). Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability - the essence of hindsight. *See, e.g., Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985) (“The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time.”). In this case, the Board fell into the hindsight trap.

Also see *Ecolochem, Inc. v. Southern California Edison Company* 227 F.3d 1361 (Fed.

Cir. 2000) which held at page 1375 that:

“However, there still must be evidence that “a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.”

In re Rouffet, 149 F.3d at 1357, 47 USPQ2d at 1456; see also *In re Werner Kotzab*, 217

F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (“[A] rejection cannot be predicated on the mere identification....of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.”) Here, there was no such evidence presented.”

Further, figure 15 of Maccaferri illustrates how the panels are suspended from a ceiling. The suspension posts 1p, 2p, 3p and 4p of Maccaferri may be molded integral with the tile body 10. Each of the posts is mounted within an axial board 33 which is aligned with the sound wave receiving opening 15. The upper end of the post is connected to a nailing channel 40. There is no teaching in Maccaferri that the acoustical plastic tile units can be connected to a grid as taught by the ‘228 Wendt reference. Maccaferri requires the panels to touch for sound absorption purposes and combining ‘228 and teaches that the panels are self-supporting.

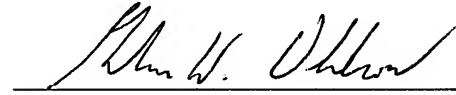
Further, claims 1, 9, 18, 29 and 32, as amended, now require a pair of tapered parallel edges that are formed by the intersection of the side walls of the panel with the bottom wall of the panel. Upon review of the acoustical units of Maccaferri (figures 1-3) it is clear that none of the edges formed by the intersection of side walls and the bottom wall are parallel since each side wall has a distinctive shape. The opposite is true. Each edge formed in the acoustical unit of Maccaferri is sloped with a varying degree or in the opposite direction from an opposing edge. There are no two edges that are tapered and parallel. Thus, claim 1-32 are not anticipated or rendered obvious by Maccaferri in view of Wendt.

In light of the foregoing amendments, Applicants believe that claims 1-32 are allowable under 35 U.S.C. 102, 103 and 112. Therefore, the examiner is respectfully requested to

withdraw the rejections set forth in the Office Action of July 01, 2003 and allow these claims to pass onward to allowance.

Date: 3 Nov. '03

Respectfully submitted,



Glenn W. Ohlson
Registration No.: 28,455
Barnes & Thornburg
PO Box 2786
Chicago, Illinois 60690-2786
312-357-1313
312-759-5646 Fax
312-214-4811 Direct